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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Linda Morales

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TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

WONG, WARNER

ART UNIT

PAPER NUMBER

2471

MAIL DATE

DELIVERY MODE

12/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/960,008	Applicant(s) MORALES ET AL.	
	Examiner WARNER WONG	Art Unit 2471	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,8,9,12-18 and 20-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,8,9,12-18 and 20-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 3, 6, 8 and 30 rejected under 35 U.S.C. 102(e) as being anticipated by Dolan (2002/0057653).

Regarding claim 1, Dolan describes a method for performing wireless communications between base stations, comprising:

communicating bearer traffic for a packet-switched communication session between a mobile station and a first base station (BS) associated with a first type of wireless system (fig. 2 and paragraphs 8 & 25, a vendor-specific base station with a rigid interconnection protocol);

determining if handoff is required from the first base station to a second base station (BS) associated with a second different type of wireless system (fig. 2 and paragraph 10, hand-off to a vendor-specific base station with a rigid protocol);

in response to determining that the handoff is required, sending a message from the first base station to the second base station, the message indicating to the second

base station that handoff is required (fig. 6, "source transfer request" from source BS to target BS via MSC).

Dolan further describes that the first and second BS are of different vendors using different customized protocols (fig. 1-4 & paragraph 7-9 & 11, combining and interconnecting incompatible, vendor-specific or non-upgraded network components such as base stations).

Regarding claims 3, 6 and 8, Dolan suggests:

the first BS comprises an IS-2000 base station and wherein communication the bearer traffic comprises communication the bearer traffic between the mobile station and the IS-2000 base station (fig. 2 & paragraph 7, BS 220 may be of a new-technology CDMA, i.e. CDMA-2000, which is IS-2000).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4-5, 7, 9 & 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan as applied to claim 1 above, and further in view of Bender (US 2006/0148511).

Regarding claims 4-5, Dolan describes a handoff determination between the first type of BS exemplified as a CDMA BS to a second type of BS as set forth in claim 3, but fails to describe that the second type of BS may be an HDR/1xEV BS.

Bender also describes the forwarding the mobile's messages/communication, particularly from a CDMA (IS-2000) BS to a HDR (i.e. 1xEV) BS (fig. 1, paragraph 44) which may be for a handoff (paragraph 30).

It would have been obvious to one with ordinary skill in the art at the time of invention by applicant to specify that the second type of BS of Dolan being a HDR/1xEV type as in Bender.

The motivation for combining the teachings is that it is highly desirable to forward messages from one type of radio-communications to another (Bender, paragraphs 7, 9).

Regarding claims 7 and 9, Dolan and Bender combined further suggest: the handoffs determination may be from a HDR/1xEV BS to a CDMA/IS-2000 BS (Bender, fig. 1, paragraphs 7 & 9, message forwarding is understood to be from/to CDMA radio network to/from HDR radio network 122).

Regarding claim 12, Dolan and Bender combined further describe sending another message from the HDR (second) BS to the CDMA/IS-2000 (first) BS to initiate a handoff procedure (Dolan, fig. 6, "source transfer acknowledgement" messages from target BS to source BS via MSC).

Regarding claim 13, Dolan and Bender combined further describe sending a further message from the first base station to the second base station to indicate that

the mobile station has been directed to hand off to the second base station (Dolan, fig. 6, "source transfer commit" messages from source BS to target BS via SDU).

Regarding claim 14, Dolan and Bender combined further describes that the message comprises sending the message over a link between the first BS and the second BS (Dolan, fig. 6, from Source BS to MSC to target BS).

Regarding claim 15, it is well known that the soft (make-before-break) handoff such as that of Dolan may be degraded and become a hard (break-before-make) handoff (column 24, lines 33-35) in adverse situations.

Claims 16- 23 are apparatus claims drawn to the limitations deriving from method claims 1-15; hence they are rejected using the same rationale.

Claims 24-29 are article claims drawn to the limitations deriving from method claims 1-15; hence they are rejected using the same rationale.

Regarding claims 30-32, Dolan suggests:

a link directly connecting the first base station and the second base station for sending messages (fig. 2, links 231 & 233).

Response to Arguments

3. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner noted that in previous Office Action dated July 18, 2007, single reference Dolan was used as a 103 rejection. However, in reviewing Dolan, the

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Examiner now understands that Dolan does explicitly describe a wireless infrastructure with incompatible system components, hence equating to the claimed “different type of wireless system” as argued.

On p. 10 paragraph 2 of applicants’ remarks dated 9/20/2007, the applicants argue: “As conceded by the Office Action, ‘Dolan fails to explicitly describe that the first and second BS are of different vendors.. Nevertheless, it appears that what the Office Action is conceding .., is that Dolan fails to disclose a first base station system (that communicates according to a first Protocol) determining if a handoff is requires to a second base station that performs wireless communication according to a second different protocol, as recited in claim 24.’”

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Czaja (US 6,584,087) describing intergeneration soft handoffs, Agre (US 5,978,769) describing coexisting GSM & CDMA wireless telecom networks, .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WARNER WONG whose telephone number is (571)272-8197. The examiner can normally be reached on 6:30AM - 3:00PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Chi Pham can be reached on (571) 272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chi H Pham/
Supervisory Patent Examiner, Art
Unit 2471

/W. W./
Examiner, Art Unit 2471